

**REMARKS/ARGUMENTS**

By this Amendment, claims 15-26 have been canceled and claims 1 and 3 have been amended. Claims 1-14 remain in the application.

***Election/Restrictions***

Applicants affirm the election, without traverse of Group 1, claims 1-14. Claims 15-26 to the non-elected invention have been cancelled, although applicants retain the right to present claims 15-26 in a divisional application.

***Claim Amendment Support***

The amendment to claim 1 is supported, for example, by FIG. 5, illustrating the planar femoral surface 64 of the guide arm portion 48 lying in a plane spaced from the plane of the planar tibial surface 66, both of which planes are illustrated as being substantially parallel to and spaced from the distal femoral resection plane 16 defined by the cutting guide slot 58 (See also page 13, lines 3-5).

The amendment to claim 3 is supported, for example, by FIGS. 1 and 2, which illustrated discrete femoral shims 26, 28, 30 and discrete tibial shims 32, 34. See also FIG. 14, which illustrates a knee joint with the combination cutting and spacer guide 24 in place, with a femoral shim 26 and no tibial shim and FIG. 15 which illustrates a knee joint with the combination cutting and spacer guide 24 in place, with both a femoral shim 26 and tibial shim 32.

***Claim Rejections – 35 USC §102***

The rejection of claims 1-10 and 14 under 35 U.S.C. §102(b) as being anticipated by Elliot et al. (US Patent No. 5,720,752) is respectfully traversed.

In Elliot et al., the gauge 50 is placed on the distal femur *after* the distal femoral cut has been made (Elliot et al. col. 11, lines 38-40). The slot 57 is positioned for shaping the anterior femur, not for making the distal femoral cut (see Elliot et al. col. 11, lines 46-49, 56-58). Thus, the slot 57 is oriented in a plane perpendicular to the plane of a slot that would be used to make a distal femoral cut. Moreover, the plane defined by the slot 57 is perpendicular to the upper and lower planes of the element labeled as the guide arm portion on page 6 of the Office Action. Accordingly, Elliot et al. does not anticipate independent claim 1 and its dependent claims 2 and 5-14.

The portions of the Elliot et al. device labeled as the “tibial shim arm” and “femoral shim arm” on page 6 of the Office Action appear to be integral parts of the single paddle body 52. These areas of the paddle body 52 do not appear to be discrete elements separately mountable to a cutting guide. Accordingly, Elliot et al. does not anticipate independent claim 3 and its dependent claim 4.

### ***Conclusion***

It is believed that all of claims 1-14 are in condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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